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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/288,589 04/08/99 SOCCI

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EXAMINER

IM52/1005

HONEYWELL INTERNATIONAL INC.
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JOHNSTONE, A

ART UNIT

PAPER NUMBER

1733

DATE MAILED:

10/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/288,589

Applicant(s)
Socci et al.

Examiner
Adrienne Johnstone

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1733



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 Sep 1999 and 14 Jul 1999
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) 7, 8, 12, and 23-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-11, and 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1, 6, 7, 11 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a fiber-reinforced article comprised of at least two plies wherein each of the plies comprises rubber and cord made from melt-spinnable, non-metallic, multifilament fiber, classified in class 428, subclass 105.
 - II. Claims 23 and 24, drawn to a tire comprising the fiber-reinforced article as the tire belt, classified in class 152, subclass 527.
 - III. Claim 25, drawn to a method of making a tire comprising incorporating therein the fiber-reinforced article, classified in class 156, subclass 123.
 - IV. Claims 26-28, drawn to a method of making the fiber-reinforced article wherein fiber reinforcement in a third dimension is present in the form of stitches or folds, classified in class 156, subclass 60.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an article reinforcing other composites (hoses, drive belts, conveyor belts, etc.) and the inventions are deemed patentably distinct since there is nothing on this record to show them to be

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obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Inventions III-IV and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as one in which the article is incorporated into composites other than tires (hoses, drive belts, conveyor belts, etc.) or one in which the article is not provided with fiber reinforcement in a third dimension in the form of stitches or folds.

5. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make another and materially different product such as a tire comprising the fiber-reinforced article as a component of the tire other than the belt (carcass, bead reinforcement, etc.).

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6. Inventions IV and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make another and materially different product such as a composite other than a tire comprising the fiber-reinforced article as a component thereof or a fiber-reinforced article not provided with fiber reinforcement in a third dimension in the form of stitches or folds.

7. Inventions III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all the particulars of the subcombination are not recited in the combination claim. The subcombination has separate utility such as a method of making a fiber-reinforced article to reinforce composites other than tires (hoses, drive belts, conveyor belts, etc.).

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. If Invention I is elected, further elections of species are required as set forth below.

10. This application contains claims directed to the following patentably distinct species of the claimed invention: a fiber-reinforced article comprised of at least two plies wherein each of the plies

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comprises rubber and cord made from melt-spinnable, non-metallic, multifilament fiber and the at least two plies is **either** three plies **or** four plies (specification p. 12 line 10 - p. 13 line 9, Figures 2 and 3).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. Claim 11 is generic to a plurality of disclosed patentably distinct species comprising a fiber-reinforced article comprised of at least two plies wherein each of the plies comprises rubber and

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cord made from melt-spinnable, non-metallic, multifilament fiber, the article having fiber reinforcement in a third dimension, the reinforcement being **either** continuous chain stitches **or** zigzag stitches **or** cross-stitches **or** a combination of all three stitches **or** folds forming the edges of the longitudinal direction of the article (specification p. 13 line 11 - p. 16 line 20, Figures 4-8). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. If Invention IV is elected, a further election of species is required as set forth below.

13. This application contains claims directed to the following patentably distinct species of the claimed invention: a method of making the fiber-reinforced article wherein fiber reinforcement in a third dimension is provided in the form of **either** stitches **or** folds (specification p. 13 line 11 - p. 16 line 20, Figures 4-8).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon,

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including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

14. During a telephone conversation with Bronwen Loeb (Reg. No. 43,516) on July 14, 2000 a provisional election was made with traverse to prosecute the invention of Group I and the species wherein the at least two plies is three plies and the fiber reinforcement in a third dimension is folds forming the edges of the longitudinal direction, claims 1-6, 9-11, and 13-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7, 8, 12, and 23-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

16. Once allowable subject matter is determined by the examiner, any tire or method claim above incorporating all of the limitations of a fiber-reinforced article claim allowable in substance will be rejoined.

Claim Rejections - 35 USC § 112

17. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18. Claims 1-6, 9-11, and 13-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It appears from the specification p. 9 lines 17-19 that a PEN cord meeting the twist multiplier limitation would necessarily meet the initial compressive modulus limitations. Clarification is required.

19. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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20. Claims 1-6, 9-11, and 13-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are numerous antecedent basis problems throughout the claims. For example, the recited orientation angles are in fact **cord** angles rather than "fiber" angles, and in claim 5 it is not clear that the number of the at least two plies is three (change "comprising" to -- in which said at least two plies are).

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Inada et al. (5,246,051).

Conclusion

23. The examiner may make further prior art rejections in the next Office action depending on applicants' response to the examiner's request for clarification in paragraph 18 above.

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24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne Johnstone whose telephone number is (703) 308-2059. The examiner can normally be reached on Monday through Friday from 11:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for official after final faxes and (703) 872-9311 for all other official faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Adrienne Johnstone

October 2, 2001



Adrienne Johnstone

Primary Examiner

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